

REMARKS

I. Status of Claims

Claims 1-47 are currently pending and stand rejected. No amendments are made at this time. Accordingly, no new matter has been added.

Applicant respectfully acknowledges the withdrawal of the provisional obviousness-type double patenting rejection over copending Application No. 10/612,920 in view of the terminal disclaimer filed February 23, 2007. Applicant also respectfully acknowledges the withdrawal of the prior provisional rejection under 35 U.S.C. § 103 over copending Application No. 10/612,920.

II. Rejection Under 35 U.S.C. § 102

The Examiner maintains the rejection of claims 1-47 under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 6,113,925 ("de la Poterie") for reasons of the record. See Final Office Action at 2-4. Applicant continues to traverse for reasons of the record and the following additional reasons.

The Examiner continues to assert that *de la Poterie* teaches examples of film formers, specifically polyurethanes, that can be used in the composition of the present claims. See *id.* at 3. In response to Applicant's amendment submitted on February 23, 2007, the Examiner contends that the amendment to claim 1 "merely further describes the characteristics of the polymer." *Id.* at 4. The Examiner asserts that "[s]ince polyurethane is mentioned in the prior art as the film-forming polymer and is taught by applicant as an example in the instant invention, it is anticipated that it would have the same characteristics as claimed." *Id.* In addition, the Examiner states that since "[t]he

applicant does not teach in the specification examples of a cosmetically acceptable medium, therefore, any of the cosmetically acceptable mediums known in the cosmetic art can be employed with a reasonable expectation of success." *Id.* The Examiner then concludes that the claim composition and the composition "of de la Poterie are the same" since "all of the limitations would be inherent." *Id.*

Applicant respectfully disagrees. The Examiner has not established that the presently claimed invention is anticipated by de la Poterie because de la Poterie has not been shown to teach or disclose a film-forming polymer that is soluble in an organic solvent in an amount greater than 90% by weight at 25°C, nor a composition that can form a film having a rate of mass loss of less than 0.5 mg/minute when the film is subjected to abrasion produced with a Taber abrasimeter at 23°C, as recited in, for example, Claim 1.

In relying upon the theory of inherency, the Examiner "must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." M.P.E.P. § 2112(IV) (quoting *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)) (emphasis in original). Further, to establish inherency, the Examiner bears the burden to provide extrinsic evidence, which "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Id.* (quoting *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)). "Inherency, however, may not be established by probabilities or possibilities." *Id.*

Here, the Examiner has failed to point to any evidence to meet the requisite burden of proof in support of the inherency argument. The only "evidence" the Examiner relies on is the erroneous assertion that the film-forming polymers disclosed by *de la Poterie* are "the same" as those of the presently claimed invention. See Final Office Action at 4.

Contrary to the Examiner's assertion, *de la Poterie* does not teach that its compositions contain a film-forming polymer "that is soluble in an organic solvent in an amount greater than 90% by weight at 25°C," as recited in, for example, Claim 1. *De la Poterie* discloses that its film-forming materials must be dispersed in an aqueous medium. See *de la Poterie*, col. 2, lines 24-40; col. 4, lines 27-33; claim 1. As demonstrated in the Declaration under 37 C.F.R. § 1.132 of Bouchra DINI ("Declaration"), filed concurrently herewith, film-forming materials able to be dispersed in an aqueous medium as taught by *de la Poterie* cannot meet the organic solvent solubility limitation as recited in, for example, Claim 1. A film made from SANCURE® 878 (now sold under the commercial name Avaluare® UR 450)¹ and placed in butyl acetate for 1 hour at room temperature was insoluble in an amount greater than 90% by weight of polymer at 25°C. See Declaration ¶¶ 8-10. This is due, in part, to the fact that the groups of the film-forming polymer that make the polymer soluble in an amount of 90% by weight at 25°C prevent the same polymers from being dispersed in water. Therefore, as *de la Poterie* teaches polymers in an aqueous dispersion, it cannot

¹ Applicant submits the attached letter dated November 13, 1998, from Mathilde OMNES of BFGoodrich indicating that Avaluare® UR 450 correlates to SANCURE® 878.

expressly or inherently teach a film-forming polymer soluble in an organic solvent in an amount greater than 90% by weight at 25°C.

Accordingly, as the Examiner has failed to establish each and every element of the rejected claims, Applicant respectfully requests this rejection be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any of the outstanding issues, he is respectfully urged to contact Applicant's undersigned counsel at 202-408-4368.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 15, 2007

By: Deborah M. Herzfeld
Deborah M. Herzfeld
Reg. No. 52,211

Attachments: Declaration under 37 C.F.R. § 1.132
Letter from Mathilde OMNES, dated November 13, 1998